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T. Steptoe
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: WATANABE et al.

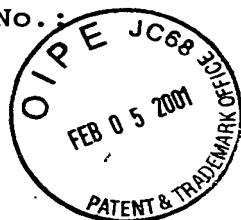
Serial No.: 09/462,796

Filed: January 13, 2000

For: SEMICONDUCTOR DEVICE, MOUNTING STRUCTURE
THEREOF AND METHOD OF FABRICATION THEREOF

Group: 2813

Examiner: Y. Huynh



TECHNOLOGY CENTER

FEB-6 2001

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RESPONSE TO RESTRICTION REQUIREMENT

Assistant Commissioner for Patents
Washington, D.C. 20231

February 5, 2001

Sir:

In response to the restriction requirement dated November 8, 2000, applicants hereby respectfully traverse this restriction requirement.

With regard to the present claims, it is respectfully submitted that both the device claims 2-7, 9-21 and 23-33 and the method claim 22 are very closely related to one another, to the point of justifying a common examination. Comparing the device claims with method claim 22, for example, it is noted that both the device claims and the method claim are directed to forming pyramidal bump electrodes onto pad electrodes arranged on a semiconductor chip using a bonding operation. The device claims include specific method features concerning the bonding operation. As such, numerous common issues will be raised between the device claims and the method claim during the examination, both in terms of searching and consideration by the Examiner.

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Accordingly, it is respectfully submitted that the common issues of these claims call for a common examination of both the device and method claims in this application. Such a common examination will avoid redundant efforts in searching and prosecuting which will almost surely result if this restriction requirement is not removed.

Further, it is urged that such a common examination is warranted, notwithstanding the fact that other methods could possibly be used for manufacturing the device, as pointed out in the Office Action. MPEP 803 specifies:

"If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions."

It is respectfully submitted that this is the situation here, given the close relationship between the device and the method claims in question. Accordingly, it is respectfully requested that the Examiner reconsider this restriction requirement in light of the above comments, and MPEP 803, and, correspondingly, remove the restriction requirement.

Finally, it is respectfully submitted that the Office Action fails to establish the distinctness between the process of making and the product made in accordance with the requirements of MPEP 806.05(f). This section of the Manual states that a restriction between a process of making and a product made is permissible:

"if the Examiner can demonstrate that the product as claimed can be made by another materially different process; defining the product in terms of a process by which it is made is nothing more than a permissible

technique that applicant may use to define the invention."

It is respectfully submitted that the Office Action fails to demonstrate that the product as claimed can be made by another materially different process as required by MPEP 806.05(f). Accordingly, it is respectfully submitted that the statements made in the Office Action are insufficient to justify the restriction requirement.

Although the applicants believe that the restriction requirement is not warranted for the reasons set forth above, in order to be fully responsive to the restriction requirement, applicants hereby elect Group I claims 2-7, 9-21 and 23-33, drawn to the device, subject to the traverse provided herein.

To the extent necessary, the applicants petition for an extension of time under 37 CFR 1.136. Please charge any shortage in the fees due in connection with the filing of this paper, including extension of time fees, to the deposit account of Antonelli, Terry, Stout & Kraus, LLP, Deposit Account No. 01-2135 (500.38090X00), and please credit any excess fees to said deposit account.

Respectfully submitted,

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